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| 10/667,872  | 09/22/2003  | Takehiko Nakano      | 09812.0377-00000    | 1172             |
| 22852   | 7590        | 08/06/2008           |                     |                  |
| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER<br>LLP<br>901 NEW YORK AVENUE, NW<br>WASHINGTON, DC 20001-4413 |             |                      |                     |                  |
| EXAMINER<br>SHAN, APRIL YING  |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 2135  |             |                      |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/667,872

## Applicant(s)

NAKANO, TAKEHIKO

## Examiner

APRIL Y. SHAN

## Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-15 and 17-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-15 and 17-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/08.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. A Request for Continued Examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9 May 2008 has been entered.
2. Claims 1, 12 and 23 have been amended. Claims 5 and 16 have been canceled. No new claims have been added. Claims 1-4, 5-15 and 17-23 are currently pending in the present application.
3. Applicant's amendments and argument have been fully considered, but are moot in view of new ground rejection as set forth below. It is noted that Applicant's arguments are directed towards limitations newly added via amendments.
4. Any objection/rejection not repeated below is withdrawn due to Applicant's amendment.

***Claim Rejections - 35 USC § 103***

5. Claims 1-4, 6-15 and 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ansell et al. (U.S. Pub. No. 2002/0104019) and in view of Conte et al. (U.S. Patent 5,845,065).

As per **claims 1 and 12**, Chatanti et al. discloses a content usage control apparatus/method for controlling use of a content under a predetermined condition, comprising:

acquiring first user identification information for identifying a first user requesting use of the content ("...the security mechanism used to allow the user to access the full program contained on the media is a combination key that includes both the media identifier..., and the playback machine identifier (e.g., client computer serial number)..." – e.g. par. [0059]. Please note a combination key corresponds to Applicant's first user identification);

*The examiner carefully considered the scope and meaning of the term "user" in the claim, which must be given its broadest reasonable interpretation consistent with applicant's disclosure, as explained in In re Morris, 127 F. 3d 1048, 1054 (Fed. Cir. 1997) and see also In re Zletz, 893 F. 2d 319, 321 (Fed. Cir. 1989), in which stating the claims must be interpreted as "broadly as their terms reasonably allow".*

*In the paragraph [0016] and [0022] of the current application's U.S. publication (U.S. 2004/0059937), both terms "apparatus" or "user" are disclosed. The Applicant does **not** expressly define a "user" is a human user. Therefore, in view of the Applicant's original disclosure, it is reasonable to interpret a "user" as "apparatus" and vice versa.*

*For the sake of the argument, even if "human user" is defined in the disclosure, the examiner respectfully points out a person with ordinary skill in the*

*art is someone having common sense and ordinary creativity (KSR v. Teleflex 550 U.S., 127 S. Ct. 1727 (2007) will easily recognize that the user identification recited in the claim and an unlock key disclosed in the Chatanti et al. can be easily replaced each other since it is merely "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." KSR at 1739*

registering the first user identification information in a database ("...a database record is maintained which records both the serial number of the playback machine and the serial number of the playback machine..." – e.g. par. [0060]) and subsequently registering a second user requesting use of the content by replacing the first user identification information in the database with second user identification information identifying the second user ("If the user is ever forced to replace their playback machine, he or she could request a new unlock key...therefore allows a new unlock key to be generated for the user" – e.g. par. [0060]. Please note a new unlock key corresponds to Applicant's second user identification information and the replaced playback machine corresponds to Applicant's second user and further note the new unlock key replaces the original combined key in the database.)

preventing further replacements to the registered second user identification information in the database in accordance with a limitation on replacing user identification information ("...an access counter is implemented so

that the database only allows this procedure to be accomplished a limited number of times..." - e.g. par. [0060]);

in response to the request for use of the content issued by the second user, determining whether the use of the content is allowed on the basis of whether the second user identification information is currently registered in the database ("...The database then confirms that the disk serial number shows a purchase against it and therefore allows a new unlock key to be generated for the user" - e.g. par. [0060]. Please note determining whether the use of the content is allowed on the basis of whether the second user identification information is currently registered in the database is deemed inherent since the database confirms/allows generating the new replacement key.).

Chatanti et al. does not expressly disclose modifying the limitation.

Conte et al. discloses such well known feature of modifying the limitation by disclosing "...the program is capable of changing its configuration or the level of performance (e.g....non-time limited configuration, or to reconfigure to change the number of users...When the user wishes to change the configuration (i.e. to change, e.g. from a time-limited analysis system to a non-time-limited analysis system..." - e.g.

It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Conte et al.'s modifying the limitation into Chatanti et al.'s replacing user identification information motivated by "pay the necessary fee to the vendor so that the user can have access to the new

configuration, without the need for loading additional software or otherwise initializing the program" (e.g. Conte et al. col. 24, line 66 – col. 25, line 13).

As per **claims 2 and 13**, Chatanti et al. – Conte et al. disclose a content usage control apparatus/method as applied in claims 1 and 12. Chatanti et al. further discloses registration is performed in response to a request issued by the first client ("The unlock key is generated as a combination of the key that user provides and a master key for that specific software application" – e.g. par. [0062]).

As per **claims 3 and 14**, Chatanti et al. – Conte et al. disclose a content usage control apparatus/method as applied in claims 1 and 12. Chatanti et al. further discloses new registration is performed only when a current number of registrations is smaller than a predetermined maximum allowable number of registrations ("...a limited number of times...." - e.g. par. [0060]).

As per **claims 6 and 17**, Chatanti et al. – Conte et al. discloses a content usage control apparatus/method as applied in claims 1 and 12. Chatanti et al. – Conte et al. further discloses wherein the limitation is a maximum number of times user identification information can be replaced (Chatanti et al. – par. [0060] and Conte et al. col. 24, line 66 – col. 25, line 13).

As per **claims 7 and 18**, Chatanti et al. – Conte et al. discloses a content usage control apparatus/method as applied in claims 1 and 12. Chatanti et al. –

Conte et al. further discloses wherein the limitation is a predetermined amount of time that must expire between replacing user identification information (Chatanti et al. – par. [0060] and Conte et al. col. 24, line 66 – col. 25, line 13)

As per **claims 8 and 19**, Chatanti et al. – Conte et al. discloses a content usage control apparatus/method as applied in claims 1 and 12. Chatanti et al. further discloses wherein when the registered first identification information for the first client is replaced with second identification information for a second client, the second client is requested to perform a particular operation (“For example, if a replacement key is requested, it may be necessary for a security question to be answered or for the key to be posted to a specific physical address or e-mail or for the person to be called back, thus allowing some identification of the person requesting the replacement key” – e.g. par. [0060]).

As per **claims 9 and 20**, Chatanti et al. – Conte et al. discloses a content usage control apparatus/method as applied in claims 1 and 12. Chatanti et al. further discloses wherein when the registered first identification information is replaced with second identification for a second client, submission of change permission information is requested from the second client or manager (“If the user is ever forced to replace their playback machine, he or she could request a new unlock key by inserting the disk into the new playback machine.” – e.g. par. [0060]).



As per **claims 10 and 21**, Chatanti et al. – Conte et al. discloses a content usage control apparatus/method as applied in claims 6 and 17. Conte et al. further discloses charging fees for changing the maximum number of times identification information can be replaced (Conte et al. col. 24, line 66 – col. 25, line 13).

As per **claims 11 and 22**, Chatanti et al. – Conte et al. discloses a content usage control apparatus/method as applied in claims 1 and 12. Conte et al. further discloses when the limitation is modified, submission of change permission information is requested from a different apparatus or a manager ("new playback machine...replacement" – e.g. par. [0060]).

As per **claim 23**, Chatanti et al. – Conte et al. discloses the claimed method of steps as applied above in claim 1. Therefore, Chatanti et al. – Conte et al. discloses the claimed for computer program described in a computer-readable format carrying out the method of steps.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See PTO -892).

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to APRIL Y. SHAN whose telephone number is (571)270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/April Y Shan/  
Examiner, Art Unit 2135